

REMARKS

- Claims 1 – 4 and 6 – 12 stand rejected under 35 USC 103(a) as being unpatentable over the Glesener in view of Swain and Kunimatsu or in view of Zen.
- Claims 5 and 13 stand rejected under 35 USC 103(a) as being unpatentable over the Glesener in view of Swain and Kunimatus or in view of Zen and in further view of Nishino.
- Claims 6, 12 and 13 stand rejected under 35 USC 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 – 4 and 6 – 12 are not Obvious Under 35 USC 103(a)

Claims 1 – 4 and 6 – 12 stand rejected under 35 USC 103(a) as being unpatentable over the Glesener (US 6,267,866) in view of Swain (US 2003/0170906) and Kunimatsu (US 6,106,692) or in view of Zen (US 5,855,760). The Applicant respectfully traverses the rejection.

The Applicant respectfully submits that the Examiner has mischaracterized the primary cited reference (Glesener). Applicant further submits that upon a revised characterization of the Glesener reference the non-obviousness of the presently claimed invention will be evident.

The Examiner states in the pending Action that Glesener "discloses an apparatus for measuring total organic carbon in aqueous solution." Pending Action, page 3. The Applicant submits that Glesener does not disclose such a device and that the Glesener device is incapable of measuring TOC in an aqueous solution. Rather, the Glesener device as described in the Glesener patent merely "monitored" TOC "as a function of time and cell current" without determining the actual TOC of the sample. Glesener, column 4, lines 59 – 60. The actual measurement of TOC took place out of the device and was determined by "converting the organic carbon in solution to CO₂ by high temperature combustion." Glesener, column 4, lines 61 – 62. The Examiner cited the Glesener device as having "at least one gas-phase sensor (col. 04:62-67)" but, in actuality, the Glesener device does not contain any gas-phase sensors. The CO₂ sensor mentioned in the text cited by the Examiner in Glesener was actually contained in a separate, independent device; the device used to convert "the organic carbon in solution to CO₂ by high temperature combustion."

Thus, the Glesener device is fundamentally different than the device of the present invention. Because of these fundamental differences, the Glesener device is incapable of measuring TOC in stark contrast to the device of the present invention.

The Examiner cites Glesener in view of Swain and Kunimatsu or Zen. The Applicant submits that Swain and Kunimatsu or Zen do not supply the elements missing from Glesener and, as such, Glesener in view of Swain and Kunimatsu or Zen do not teach, fairly suggest or predict the presently claimed invention.

In view of these arguments the Applicants respectfully request the withdrawal of the pending rejection.

Claims 5 and 13 are not Obvious Under 35 USC 103(a)

Claims 5 and 13 stand rejected under 35 USC 103(a) as being unpatentable over the Glesener (US 6,267,866) in view of Swain (US 2003/0170906) and Kunimatsu (US 6,106,692) or in view of Zen (US 5,855,760) and in further view of Nishino (4,755,473). The Applicant respectfully traverses the rejection.

Applicant notes that Claim 5 is drafted correctly to an aqueous-phase sensor. Claim 5 is dependent upon Claim 4. Claim 4 adds the element of an aqueous-phase sensor to independent Claim 1.

The Applicant has properly characterized Glesener above. The Examiner cites Nishino for teaching an ion-selective electrode for measuring CO₂. A review of Nishino reveals that their sensor is for use in a gas-phase environment. In contrast, the present invention uses an ion-selective electrode for measuring CO₂ in the aqueous-phase. Nishino does not teach or suggest the use of their ion-selective sensor in an aqueous-phase environment. Applicant submits that one of skill in the art could not have predicted the use of ion-selective electrodes for the measurement of CO₂ in aqueous-phase based on the teachings of Nishino.

The Examiner cites Glesener in view of Swain and Kunimatsu or Zen and in further view of Nishino. The Applicant submits that Swain and Kunimatsu, Zen or Nishino do not supply the elements missing from Glesener and, as such, Glesener in view of Swain and Kunimatsu or Zen do not teach, fairly suggest or predict the presently claimed invention.

In view of these arguments the Applicants respectfully request the withdrawal of the pending rejection.

Claims 6, 12 and 13 are definite under 35 USC 112, second paragraph

Applicant submits that Claim 6 as pending does not recite "aqueous-phase," as stated by the Examiner. Therefore, no amendments have been made to Claim 6.

Claim 12 has been amended in concert with the Examiner's remarks. Claim 13 depends upon Claim 12 and retains the limitations of Claim 12.

Summary

In light of the above amendment and remarks, reconsideration of the subject patent application is respectfully requested. Any deficiency or overpayment should be charged or credited to Deposit Account No. 50-4515.

Respectfully submitted,



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